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FROM: Mitchell K. McCarthy, Registration No. 38,794

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Art Group 3673	571/273-8300	571/272-4100

RE: Application No. 10/772,509
In re application of: Mark Temple
Dkt. No.: MT001

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) MT001	
I hereby certify that, on the date shown below, this correspondence is being facsimile transmitted to the Patent and Trademark Office, (571) 273-8300. 37 CFR §1.8(a) on <u>06-30-06</u> Signature <u>Diana C. Anderson</u> Typed or printed name <u>Diana C. Anderson</u>		Application Number 10/772,509	Filed February 5, 2004
First Named Inventor Mark Temple		Art Unit 3673	
Examiner Fredrick Conley			

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.

I am the

<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,794</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<div style="text-align: center;">  Signature <u>Mitchell K. McCarthy</u> Typed or printed name <u>(405) 232-0621</u> Telephone number <u>6/30/2006</u> Date </div>
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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PATENT
Dkt. MT001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Mark Temple**
Application No.: **10/772,509** Group Art: **3673**
Filed: **February 5, 2004** Examiner: **Fredrick C. Conley**
For: **Supportive Upper Body Constraint Device**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant prays that the Panel's objective review will conclude that all the unresolved issues clearly raised by Applicant during prosecution, some being reiterated herein summarily, are not bona fide matters for appeal, but rather are issues that must be resolved before this case is in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS FAILED TO A PRIMA FACIE
CASE OF OBVIOUSNESS OF CLAIM 1 BY NOT SUBSTANTIATING A MOTIVATION
TO COMBINE AND MODIFY THE CITED REFERENCES

Rejection Over Tarquinio '253 in View of Robinson '575

The Examiner has persisted in mischaracterizing the cited reference and misstating the law as justification for combining these references.

For example, the Examiner maintained the rejection by stating that Robinson '575 discloses that the cover ILD is less than the base ILD. (Advisory Action of 5/15/2006, Office Action of 12/30/2005) This is a mischaracterization of the cited reference. The passage to which the Examiner points clearly states that these values have overlapping ranges; that is, in

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)

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Dianai C. Anderson

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#364809

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Robinson '575 the base ILD is in the range of 24-40, and the cover ILD is in the range of 12-45. The cover ILD being less than the base ILD is a possible result, just as is the possibility that they are equivalent or that the cover ILD is greater than the base ILD. Applicant has argued and the Examiner has not rebutted, however, that Robinson '575 is wholly silent regarding teaching or suggesting any desirability that the cover ILD be less than the base ILD. The Examiner's mischaracterization leaves an unresolved factual issue that must be resolved before this case is in condition for appeal.

The embodiments as claimed require that the base ILD be greater than 40 and that the cover ILD be less than the base ILD. The following is a diagram that Applicant and Examiner stipulate to as being representative of what the cited references teach or suggest:

	<u>base ILD > 40</u>	<u>cover ILD < base ILD</u>
Tarquinio '253	no	yes
Robinson '575	24-50	possible

Given this, the Examiner erroneously believes that because Tarquinio '253 discloses the second element, the analysis simplifies to the case of an obviousness rejection over a single prior art reference. From that erroneous vantage point he views this is a simple case dealing with the presumed obviousness of overlapping ranges. Particularly, the Examiner maintained the rejection by stating: "It is well known in the art that to merely change a range of values for a structural element, such as the ILD ratio of the base, is considered an obvious modification."

The Examiner's rejection is clearly erroneous and reversible error. What the Examiner fails to acknowledge is that he is obligated to provide a motivation for combining these two references to arrive at the present embodiments as claimed in order to sustain a prima facie case of obviousness. A rejection simply based on the fact that one reference discloses one element and the other reference discloses the other element just isn't in accordance with the law.

The Examiner's stated motivation to combine the references is "It would have been an [sic] obvious to have the ILD ratio greater than 40 as taught by Robinson in order to render the overall mattress of Tarquinio somewhat firmer." This is a broad-brush form-over-substance attempt which should be repudiated because it certainly falls short of the obligatory reasoned statement...useful in judging the propriety of continuing prosecution of the application. 35 USC

132 Applicant rebutted the Examiner's stated motivation but the Examiner did not reply. (see Applicant's Response of 5/1/2006, ppg. 4-9)

Rejection Over Walpin '993 in View of Robinson '575

This rejection is weaker than that above because, unlike Tarquinio '253, the Examiner has stipulated that Walpin '993 does not disclose the second element:

	<u>base ILD > 40</u>	<u>cover ILD < base ILD</u>
Walpin '993	no	no
Robinson '575	24-50	possible

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If Applicant is incorrect, meaning this case is in fact ready for appeal, then the Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

For a *prima facie* case of obviousness to exist, there must be an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999).

In the absence of express motivation, the Examiner's statement that modifications of the prior art to meet the claimed invention would have been within the knowledge of a skilled artisan, because all aspects of the claimed invention are individually taught by different references, is not sufficient to substantiate the motivation or suggestion required by a bona fide *prima facie* case of obviousness. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & #364809

Inter. 1993); *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999); MPEP 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01 In this case the Examiner has provided no evidence whatsoever that the cited references consider the combination to be desirable. Clearly, the Examiner's rejection is based on an unresolved legal issue that must be resolved before this case is in condition for appeal.

Applicant now prays for an objective review of the facts of this case and a conclusion that the unresolved legal and factual issues must be resolved before this case should proceed to appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS FAILED TO MAKE A PRIMA FACIE CASE OF OBVIOUSNESS OF CLAIM 7 BY NOT SUBSTANTIATING A MOTIVATION TO COMBINE AND MODIFY THE CITED REFERENCES

Applicant has argued that the Examiner's combining the viscoelastic material of Tarquinio '253 for the cover of Walpin '993 defeats the intended purpose of Walpin '993. (see **Applicant's Response of 5/1/2006, pg. 15**) Particularly, the raised nodules of Walpin '993 are intended to provide air circulation to the user's skin. The skilled artisan knows that making the nodules of viscoelastic material would be useless because it has insufficient compressive strength to maintain the nodule structure under the weight of the user. The Examiner has not replied substantively, but rather staked out an arbitrary position by stating "it is widely known to employ a variety of materials..." without comment on their inherent inability to perform the purpose of the cited reference. This is a factual issue that must be resolved before this case is in condition for appeal.

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If Applicant is incorrect, meaning this case is in fact ready for appeal, then the Panel must find in the underlying facts "substantial evidence" that adequately supports the legal conclusion of obviousness. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review

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Applicant now prays for an objective review of the facts of this case and a conclusion that the unresolved factual issue must be resolved before this case should proceed to appeal.

Respectfully submitted,

By: 

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